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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,379	02/28/2002	Akemi Hirotsune	H&A-108	1244

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MATTINGLY, STANGER & MALUR, P.C.
Suite 370
1800 Diagonal Road
Alexandria, VA 22314

EXAMINER

AUGUSTIN, EVENS J

ART UNIT PAPER NUMBER

3621

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,379

Applicant(s)

HIROTSUNE ET AL.

Examiner

Evens Augustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

Claims 1-6 and 8-16 have been examined.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 and 8-10, 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arataki et al. (U.S. 5774434), in view of Dimitri et al. (U.S. 6574424).

3. The United States Patent and Trademark Office is interpreting the claims as displaying prerecorded information in an area of optical disk and recording new information over the prerecorded information/data. In this case, the prerecorded data is advertisement.

As per claims 1-6 and 12-16, Arataki et al. discloses an invention that relates to a recording and/or reproducing apparatus for a recording medium, with a display unit. The invention comprises of:

- New data is recorded on an area where there is pre-existing data, thereby overwriting the pre-existing data (column 20, lines 40-45)
- The system overwrites the pre-existing data on the disk (column 20, lines 4-10)
- Recording medium having a data recording area on which a data recording and/or reproducing operation is carried out, and a management data area on which management

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data for managing a recording and/or reproducing operation for the recording medium are recorded (column 4, lines 30-36)

- A display unit composed of a liquid crystal display, and an operation state, a mode state, a reproduction advancing time, a record advancing time, a track number, etc. are displayed thereon under control of the system controller (column 9, lines 66-67, column 10, lines 1-3)
- Contains data management that identifies data to be recorded on disk (column 10, lines 10-18)

Arataki et al. does not teach a recording medium with pre-recording data, such as advertisement. However, Dimitri et al. teaches a method for storing commercials on DVDs (column 6, lines 18-28). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to pre-record advertisements on an optical disk. It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to pre-record advertisements on an optical disk because it would reduce the costs involved in making the disks (column 2, lines 4-6), and it would provide a new platform to advertise to the captive customers of optical disks.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al. (U.S. 6,742,147) and Dimitri et al. (U.S. 6,574,424), in view of Ueseka et al. (US 6,044,157).

As per claim 11, Sasaki et al. and Dimitri et al.'s inventions have previously been disclosed above.

Sasaki et al. and Dimitri et al. did not explicitly describe a method/system in which data recorded on an optical disk is encrypted. However, Ueseka et al. describes a method/system that teaches encrypted data from an optical disk such as DVD (column 20, lines 11-12). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to encrypt pre-recorded data on an optical disk because it prevent piracy of the disks (column 4, line 56) by enabling the prohibition of illegal copies and malfunctions to be achieved (column 6, lines 51-52).

Conclusion

1. *Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that if the applicant is preparing to respond, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Hisamatsu et al. (US 5889747)** - The present invention provides a recording device and dubbing system, in which inputted information is sequentially recorded at a

recording medium and only information determined to be desired by the user remains on the recording medium while information determined not to be desired by the user can be erased

- **Ando et al. (US 6505964)** - The present invention relates to an information storage medium represented by a large-capacity optical disc and a digital information recording/playback system using the medium
- **Nagai et al. (US 6938162)** - The present invention relates to an optical disk, an optical disk recording and reproducing apparatus, a method for recording, reproducing and deleting data on an optical disk, and an information processing system. In particular, the present invention relates to an optical disk, an optical disk recording and reproducing apparatus, a method for recording, reproducing and deleting data on an optical disk, and an information processing system which can prevent unauthorized digital copying from being performed from an optical disk, on which data such as AV data (Audio and Visual Data) including image data of movies and audio data of music which are protected with copyrights is recorded, to another recording media such as an optical disk of another recording type or the like.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

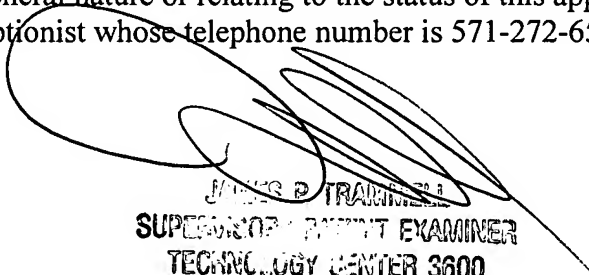
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
February 20, 2006
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JAMES P. TRAMMEL
SUPERVISOR PATENT EXAMINER
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